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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,806	05/04/2001	Jen Sheen	00786/389002	7904

21559 7590 09/19/2002

CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON, MA 02110

EXAMINER

COLLINS, CYNTHIA E

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 09/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,806

Applicant(s)

SHEEN, JEN

Examiner

Cynthia Collins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-53 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8 and 10-16, drawn to a method of producing a plant having increased disease resistance using a nucleic acid encoding a CDPK2 polypeptide, classified in class 800, subclass 279, for example.
- II. Claims 1-7 and 9-16, drawn to a method of producing a plant having increased disease resistance using a nucleic acid encoding a CDPK4 polypeptide, classified in class 800, subclass 279, for example.
- III. Claims 17-18, drawn to a method of conferring pathogen resistance on a plant involving a nucleic acid encoding a CDPK2 polypeptide, classified in class 800, subclass 265, for example.
- IV. Claims 17-18, drawn to a method of conferring pathogen resistance on a plant involving a nucleic acid encoding a CDPK4 polypeptide, classified in class 800, subclass 265, for example.
- V. Claims 19-23 and 25-26, drawn to a method for breeding pathogen resistance into plants using a transgenic plant comprising a transgene encoding a CDPK2 polypeptide, classified in class 800, subclass 268, for example.
- VI. Claims 19-22 and 24-26, drawn to a method for breeding pathogen resistance into plants using a transgenic plant comprising a transgene encoding a CDPK4 polypeptide, classified in class 800, subclass 268, for example.

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- VII. Claims 27-35, drawn to a non-naturally occurring plant that expresses a nucleic acid molecule encoding a CDPK2 polypeptide, classified in class 800, subclass 298, for example.
- VIII. Claims 36-53, drawn to a non-naturally occurring plant that expresses a nucleic acid molecule encoding a CDPK4 polypeptide, a vector and a cell, classified in class 435, subclass 320.1, for example.

The inventions are distinct, each from the other because of the following reasons:

Claims 1-7 and 10-16 link(s) inventions I and II. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claims 1-7 and 10-16.

Claims 17-18 link(s) inventions III and IV. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claims 17-18. Claims 19-22 and 25-26 link(s) inventions V and VI. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claims 19-22 and 25-26.

Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are

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no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971).

See also MPEP § 804.01.

Inventions I-VI are unrelated methods. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation or different effects. The methods of Inventions I-II require the provision of a plant cell and the regeneration of a plant, which is not required by the methods of Inventions III-VI. The methods of Inventions III-IV require crossing a pathogen resistant plant with a pathogen susceptible plant, which is not required by the methods of Inventions I-II or V-VI. The methods of Inventions V-VI require selecting a plant that expresses a nucleic acid encoding a CDPK and selecting pathogen resistant progeny, which is not required by the methods of Inventions I-IV. Furthermore Inventions I and II require the use of structurally different polynucleotides. Likewise, Inventions III and IV require the use of structurally different polynucleotides. Likewise, Inventions V and VI require the use of structurally different polynucleotides. Therefore, where structural identity is required, such as for expression, the different sequences have different effects.

Inventions VII and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the non-naturally occurring plant cell can be used in a

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materially different process of using that product, such as a method of producing a recombinant protein.

Inventions VIII and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the non-naturally occurring plant cell can be used in a materially different process of using that product, such as a method of producing a recombinant protein.

Inventions VII-VIII are unrelated products. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions represent non-naturally occurring plants comprising structurally different polynucleotides. Therefore, where structural identity is required, such as for expression, the different sequences have different effects.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter, and the requirement for different areas of search, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

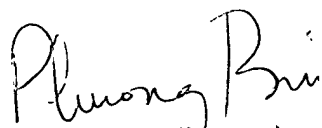
Remarks

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (703) 605-1210. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

CC
September 17, 2002


PHUONG T. BUI
PRIMARY EXAMINER 9/18/02